



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 4539-0110P																	
	Application Number 10/693,564-Conf. #3603	Filed October 27, 2003																	
	First Named Inventor Hiromi KATOH et al.																		
	Art Unit 2871	Examiner P. Vu																	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table><tr><td><input type="checkbox"/></td><td>applicant /inventor.</td><td><u>Robert W. Downe #48,222</u></td><td>Signature</td></tr><tr><td><input type="checkbox"/></td><td>assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td>Terrell C. Birch</td><td>Typed or printed name</td></tr><tr><td><input type="checkbox"/></td><td>attorney or agent of record. Registration number _____</td><td>(703) 205-8000</td><td>Telephone number</td></tr><tr><td><input checked="" type="checkbox"/></td><td>attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>19,382</u></td><td>April 12, 2006</td><td>Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>				<input type="checkbox"/>	applicant /inventor.	<u>Robert W. Downe #48,222</u>	Signature	<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Terrell C. Birch	Typed or printed name	<input type="checkbox"/>	attorney or agent of record. Registration number _____	(703) 205-8000	Telephone number	<input checked="" type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>19,382</u>	April 12, 2006	Date
<input type="checkbox"/>	applicant /inventor.	<u>Robert W. Downe #48,222</u>	Signature																
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Terrell C. Birch	Typed or printed name																
<input type="checkbox"/>	attorney or agent of record. Registration number _____	(703) 205-8000	Telephone number																
<input checked="" type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>19,382</u>	April 12, 2006	Date																



Docket No.: 4539-0110P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Hiromi KATOH et al.

Application No.: 10/693,564

Confirmation No.: 3603

Filed: October 27, 2003

Art Unit: 2871

For: OPTICAL SHIFTER AND PROJECTION TYPE
OPTICAL DISPLAY SYSTEM

Examiner: P. Vu

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In addition to the Notice of Appeal which is being concurrently filed, Applicants respectfully request a Pre-Appeal Brief Conference to consider the issues raised in the Final Office Action dated January 13, 2006, that finally rejected claims 1, 2, 4-6, 8-14. No amendments are being filed with this request.

Summary of Arguments

Applicants respectfully submit that the Examiner has made the following clear errors:

(1) the Examiner's rejection is clearly erroneous because it omits the feature of a liquid crystal element, in each of a first and second optical shifting section, including a first liquid crystal cell and a second liquid crystal cell as recited in claim 4;

(2) the Examiner's rejection is clearly erroneous because Okamura fails to teach or suggest the claimed shift ratio, as recited in claims 1 and 4; and

(3) the Examiner's rejection is clearly erroneous because it relies on improper hindsight reasoning in rejecting claims 1 and 4.

Remarks

The Examiner's Rejection Fails to Establish Prima Facie Obviousness for all Claimed Elements

Claim 4 recites, among other things, "a first optical shifting section and a second optical shifting section ... each of the first and second optical shifting sections comprising: a liquid crystal element including a first liquid crystal cell and a second liquid crystal cell"

The Final Office Action treats claim 4 as being comparable to claim 1 and states that, "Okamura teaches ... each of the first and second optical shifting section includes: a liquid crystal element including a liquid crystal cell (Fig. 30, element 73 and 75), ..." Nothing further is stated regarding the claimed "first liquid crystal cell" and "second liquid crystal cell," as recited in claim 4.

Thus, the Final Office Action fails to address at least the claimed "first liquid crystal cell" and "second liquid crystal cell."

Accordingly, Applicants submit that the Office Action does not address each and every element of claim 4. Applicants request that the rejection of claim 4 be reconsidered and withdrawn.

The Examiner's Rejection is Clearly Erroneous Because Okamura Fails to Teach or Suggest the Shift Ratio in the Context of the Claim

Claim 1 is directed to embodiments of an optical shifter, and recites "wherein the magnitude of shift caused by the first optical shifting section between optical axes of the incoming and outgoing light rays thereof is substantially twice greater than that of shift caused by the second optical shifting section between the optical axes of the incoming and outgoing light rays thereof" (paragraph 0119; Fig. 10).

Claim 4 is directed to embodiments of an optical shifter, and recites "wherein the ratio of the magnitude of shift caused by the first optical shifting section between the optical axes of the incoming and outgoing light rays thereof to that of shift caused by the second optical shifting section between the optical axes of the incoming and outgoing light rays thereof is substantially equal to either two to one or one to two" (Fig. 22).

The Final Office Action provides as evidence of these claimed features a statement at column 6 of Okamura that, "the reproducibility of the shifting amount of the optical axis of respective birefringent plates is determined by the thickness thereof" (col. 6, lines 27-31) (Final Office Action at page 2, line 4 of the first paragraph; at page 3, lines 12-16, 20-21). The statement is presented in the context of an optical axis shifting means that can shift the optical axis without the need of a mechanical mechanism (col. 6, lines 23-28). No further evidence in the prior art is provided to show the claimed features.

On the other hand, claim 1 as well as claim 4 recite a specific relationship between the magnitude of shift caused by the first optical shifting section and the magnitude of shift caused by the second optical shifting section. The statement in Okamura refers to shifting amount

(magnitude of shift) of each respective birefringent plate, but not a relationship between shift amounts. Thus, Applicants submit that Okamura does not disclose at least the above-stated claimed features.

For at least this reason, Applicants request that the rejection be reconsidered and withdrawn.

The Examiner's Rejection is Clearly Erroneous Because it Relies on Knowledge Gleaned Solely from Applicants' Disclosure, i.e. improper hindsight reasoning

The Examiner pieces together Applicants' own disclosure in support of a rational for obviousness.

In particular, the Final Office Action admits that, "Okamura does not explicitly teach the magnitude of the shift caused by the first optical shifting section between the optical axes ..." To make up for the deficiency, the Final Office Action relies on Applicants' own disclosure. For example, the Final Office Action states that "applicant admits that the magnitude of the shift is proportional to the thickness t ... and element 10'a is twice as thick as the second optical shifting section 10'b" (Final Office Action at page 3, lines 16-18).

Applicant submits that the knowledge that element 10'a is twice as thick as the second optical shifting section 10'b constitutes knowledge gleaned only from applicant's disclosure, i.e., impermissible hindsight (M.P.E.P. § 2145 X.A.).

Accordingly, at least because there is insufficient motivation, Applicants respectfully submit that the rejection fails to establish *prima facie* obviousness. For at least this reason, Applicants request that the rejection be reconsidered and withdrawn.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert W. Downs (Reg. No. 48,222) at the telephone number of (703) 205-8000, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: April 12, 2006

Respectfully submitted,

By Robert W. Downs #48,222
Terrell C. Birch
Registration No.: 19,382
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicants